**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

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| Applicant: | Douglas J. MATZKE, et al. | Confirmation No.: 4485 |
| Application Serial No.: | 10/796,946 | |
| Filed: | March 10, 2004 | |
| Title: | IMPOSING AND RECOVERING CORRELITHM OBJECTS | |
| Group Art Unit: | 2129 | |
| Examiner: | Wong, Lut | |
| Docket No.: | 9350.6-1 | |

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**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Sir:

The Office Action mailed July 18, 2008, has been carefully considered. Claims 1-56 remain pending. Please consider the following remarks.

## I. REJECTIONS UNDER 35 U.S.C. § 103 ARE IMPROPER

For each of the reasons noted below, the Examiner's rejection of Claims 1-56 under 35 U.S.C. § 103 as being unpatentable over Levitin, et al. ("Information and Distinguishability of Ensembles of Identical Quantum States" 2001) (hereinafter "*Levitin*") as evidenced by Matzke, et al. ("Invariant Quantum Ensemble Metrics" SPIE 2005) (hereinafter "*Matzke*") is improper.

1. On page 3 of the Office Action issued July 18, 2008 ("Office Action"), the Examiner states "The Examiner would like to clarify that it is a single reference 103 rejection, not two references 103" (emphasis added). Thereafter, just a few paragraphs below the above-quoted statement on the same page of the Office Action, the Examiner also asserts "In response to applicant's conclusory arguments against the references individually, one cannot show obviousness by attacking references individually where the rejections are based on combinations of references" (emphasis added). Thus, the Examiner appears to have indicated that the § 103 rejection is based upon a single reference in order to dismiss Applicants'

arguments that one of the references does not qualify as prior art and that the § 103 rejection is based upon a combination of references in order to dismiss Applicants' arguments that "all limitations" of the claims are not disclosed. These two positions advanced by the Examiner appear to be contradictory and, as such, are believed to be untenable. As such, Applicants submit that the Examiner's rejection is improper.

2. On page 3 of the Office Action, the Examiner states:

> Matzke reference is applied as an evidential reference (See MPEP 2131.01) to show a) the meaning of a term used in the primary reference; b) inherent characteristic not disclosed in the primary reference.

Applicants point out that the section of the MPEP cited by the Examiner is entitled "Multiple Reference 35 U.S.C. 102 Rejections." Indeed, MPEP § 2131.01 generally discusses the limited situations and circumstances were a § 102 rejection over multiple references may be proper. However, Applicants note that the claims have been rejected by the Examiner as obvious under § 103, and not as anticipated under § 102. Therefore, MPEP § 2131.01 does not appear to be applicable. For this reason alone, Applicants submit that the Examiner's rejection is improper.

Even assuming, *arguendo*, that MPEP § 2131.01 has some applicability to a § 103 rejection, which the Applicants do not agree with, the only indication that one of the references in a multiple § 102 rejection may have a critical date after the priority date of the application appears in the third paragraph of the section. In particular, the third paragraph of MPEP § 2131.01 states "the critical date of extrinsic evidence showing a universal fact need not antedate the filing date. See MPEP § 2124." (emphasis added). Therefore, according to MPEP § 2131.01, it appears that extrinsic evidence must show either a universal fact or fall within one of the exceptions provided in MPEP § 2124.

According to MPEP § 2124, "universal facts" are "facts that include the characteristics and properties of a material or a scientific truism." On page 4 of the Office Action, the Examiner states the term "correlithm objects" is "nothing more that ensembled qubits" and cites to *Matzke* to support this proposition. However, the Examiner has not provided, and the Applicants are

unable to locate, any indication that "ensembled qubits" are a universal fact. As such, the Examiner's reliance on MPEP § 2131.01 appears to be misplaced.

In addition to the above, none of the exceptions in MPEP § 2124 to the rule that the critical reference date must precede the filing date of an application appear to apply in the present case. Indeed, as discussed in detail in the Response filed by Applicants on April 29, 2008, *Matzke* is not believed to be cited to show the level of ordinary skill in the art. Also, because *Matzke* has a critical date much later than the filing date of the present application, *Matzke* is not believed to provide evidence of the skill in the art at the time the invention was made. Based on the foregoing, Applicants submit that the Examiner's rejection is improper.

3. On page 3 of the Office Action, the Examiner states that "the Examiner attempted to identify the nucleus of the invention … and focus the search and rejection on that nucleus." However, as stated in MPEP § 2141.02 II, "Distilling an invention down to the "gist" or "thrust" of an invention disregards the requirement of analyzing the subject matter "as a whole." *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984); *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561, 1 USPQ2d 1593 (Fed. Cir.), *cert. denied*, 481 U.S. 1052 (1987) (district court improperly distilled claims down to a one word solution to a problem). In light of the clear mandates and guidance found in MPEP § 2141.02 II, Applicants submit that the Examiner's rejection is improper.

4. On page 3 of the Office Action, the Examiner "strongly suggests the applicant argue why the difference in Levitin is non obvious rather than arguing why Levitin does not disclose limitations that are either immaterial or inherent." However, the Applicants point out that all limitations of the claimed invention must be considered by the Examiner when determining patentability. *In re Lowry*, 32 F.3d 1579, 1582, 32 U.S.P.Q.2d 1031, 1034 (Fed. Cir. 1994). Indeed, no *prima facie* obviousness rejection can be established if the reference does not teach all of the limitations of the claimed invention. Moreover, according to MPEP § 2143.03, "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). Therefore, the Examiner's apparent disregard for the limitations believed by the Examiner to be immaterial or inherent is believed to be contrary to the dictates of the MPEP and legal precedent. For this reason alone, Applicants submit that the Examiner's rejection is improper.

## CONCLUSION

A Notice of Appeal pursuant to 37 C.F.R. § 41.31 is filed herewith. The Commissioner is authorized to charge the sum of $255.00 for the Notice of Appeal to Deposit Account No. 13-4900 of Munsch Hardt Kopf & Harr, P.C., referencing Attorney Docket No. 9350.6-1.

No additional fee is believed due. If, however, Applicants have miscalculated the fee due with the Notice of Appeal or this Pre-Appeal Brief Request for Review, the Director is hereby authorized to charge any fees or credit any overpayment associated therewith to Deposit Account No. 13-4900 of Munsch Hardt Kopf & Harr, P.C., referencing Attorney Docket No. 9350.6-1.

Respectfully submitted,

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Date: **August 26, 2008**

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